

REMARKS

Request to Reconsider the Finality of the Outstanding Office Action.

According to MPEP 706.07(a), a second action on the merits will not be made final if it includes a rejection on newly examiner-cited art of any claim not amended by applicant – this in spite of the fact that other claims may have been amended to require the newly cited art. In the instant application, while claim 1 stands amended in the response to the first Office Action, independent claim 5 was not amended in that response. Now, in the second and Final Action, original claim 5 is rejected solely on newly examiner-cited art (Nagashima). Consequently, it would appear that this rejection is contrary to the requirements of MPEP 706.07(a), and the finality of the present Office Action should be withdrawn.

Status of the Claims:

The Office Action dated October 20, 2005 has been received and reviewed by the applicant. Claims 1-12 are in the application. Claims 1-12 stand rejected. Claims 1 and 5 are herewith amended, and claims 1-12 remain in the application.

Claim Rejection - 35 USC § 102

Claims 1-8 stand rejected under 35 U.S.C. 102(b) as being anticipated by Nagashima (U.S. Patent No. 4,719,516), where the reference discloses a digital image processing unit 2, which includes an image reader, and a separate editing station 1 for preparing a program for running the image processing in the digital image processing unit 2. The program is stored in a non-volatile storage 3, which is plugged into the digital image processing unit 2 specifically for operating the unit 2 and for performing image processing.

The claimed invention comprises a system including a scanner for scanning hardcopy elements and a second processor electrically connected to the scanner, where the scanner includes, *inter alia*, a first processor for directing operations of the scanner and for receiving directions that are passed to other components, and a field-installed electronic card that performs additional processing on the electronic representation of the hardcopy element. The

Examiner alleges that Nagashima shows a field-installed electronic card in its disclosure of the non-volatile storage 3 that connects to the digital image processing unit 2. However, the non-volatile storage 3 does not itself perform any processing on an electronic representation of any hardcopy element, as recited in the claims. Nagashima specifically says that other elements perform the execution of the program stored in the non-volatile storage 3 (see column 4, lines 12-18).

Moreover, nothing in Nagashima shows a second processor electrically connected to the scanner for sending directions to the field-installed electronic card through the first processor, where the directions include control instructions and protocols that are provided by the second processor from field-installed control code for directing the field-installed electronic card. The Examiner argues that second processor is anticipated by the storage controller 206 in Nagashima, which is part of the system controller 20 in the digital image processing unit 2. However there is no suggestion in Nagashima that this controller 206, or any other element in the system controller 20 or the digital image processing unit 2, sends directions to any field-installed electronic card through another processor, where the directions include control instructions and protocols that are provided by the second processor from field-installed control code for directing the field-installed electronic card.

The entire architecture of Nagashima is different than the system disclosed by Applicants. The whole point of the instant system is to handle a field-installed electronic card developed by a third party at a time, for example, later than the development and sale of the scanner, where the scanner firmware is consequently unacquainted with the card. For this to happen, the invention provides for sending directions to the field-installed electronic card through a (first) processor located in the scanner, where the directions include control instructions and protocols that are provided by the second processor from field-installed control code for directing the field-installed electronic card. There is no such need in Nagashima, since the program stored in the non-volatile storage 3 is already adapted to the specific control instructions and protocols required by the digital image processing unit 2.

Consequently, element (b) of amended claim 1, and elements (c) and (d) of amended claim 5, are nowhere found, disclosed or suggested by Nagashima. Additionally, we do not believe that a field-installed electronic card

that performs additional processing on an electronic representation of a hardcopy element, and which is found in element (a3) of claim 1 and element (b) of claim 5, is found, disclosed or suggested in Nagashima.

It is axiomatic that for prior art to anticipate under § 102 it has to meet every element of the claimed invention. Anticipation under 35 U.S.C. Section 102 thus requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention. *Rockwell International Corp. v. United States* 47USPQ2d 1027, 1031 (Fed. Cir. 1998). The foregoing remarks indicate that each claim includes one or more claimed elements that are not to be found or suggested by the Nagashima reference. For anticipation to be found, all of the claimed elements must be found in Nagashima. Since that is not the case with respect to each and every one of the claims 1 – 12, as amended, the Examiner is respectfully asked to withdraw the rejection of the claims under 35 U.S.C. 102(b) and to consider allowance of the claims, as amended.

Sufficient Showing as to why the Amendments are now necessary.

Applicants believe, in accordance with the request and reasons expressed in the first paragraph of these remarks, that the finality of the present Office Action should be removed.

However, should there be a disagreement on this matter, and recognizing that this response is after a Final Rejection, Applicants believe that any amendments to the claims in this response, which are believed to place the case in condition for allowance, do not raise any issue of new matter and do not present new issues requiring further consideration or search. These amendments were not earlier presented because, as expressed in the first paragraph of these remarks, certain of the original claims were never amended (claims 5-8) and Applicants had not anticipated the direction taken by the new grounds of rejection on newly examiner-cited art and its effect on the claims, including the unamended claims. Since these amendments are now being offered after the new grounds of rejection, and after consideration of the Examiner's response to Applicant's prior arguments, the foregoing explanation is believed to constitute a sufficient showing of good and sufficient reasons as to why the amendments are now necessary and were not earlier presented. Thus, these amendments are believed to comply with the requirements in 37 CFR 1.116 for the entry of an amendment

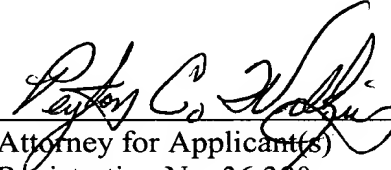
after a final rejection, thereby placing the case in condition for allowance or, at the minimum, in better form for consideration on appeal.

Summary

Should the Examiner consider that additional amendments are necessary to place the application in condition for allowance, the favor is requested of a telephone call to the undersigned counsel for the purpose of discussing such amendments.

For the reasons set forth above, it is believed that the application is in condition for allowance. Accordingly, reconsideration and favorable action are respectfully solicited.

Respectfully submitted,


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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.